

REMARKS

In the Office Action mailed September 8, 2003, the Examiner rejected claims 1-21. By way of the foregoing amendments and the markings to show changes Applicants have amend claims 1, 7, 9, 10, 14, 15, 16, 17 and 19. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

I. Claim Objections

The Office Action objected to claims 1-8 suggesting that, "in claim 1, line 12, "an" should read --the-- in order to make it clear that 'automotive vehicle' refers to the previously recited one." Such change has been made.

II. Claim Rejections – 35 USC 112

The Office Action rejected claim 9-16 under 35 USC 112 suggesting that there is "insufficient antecedent basis" for "the transparent panel" in lines 11 and 12. The term "transparent panel" has been changed to "windshield" in claim 9 and in other dependent claims to provide proper antecedent basis.

III. Claim Rejections – 35 USC 103

The Office Action rejected claims 1-21 as being, "unpatentable over Hill et al. (US patent 6,493,920) in view of Miyazaki et al. (US patent 4,883,310) and Hsieh (US patent 5,115,086)." Applicants traverse these rejections and suggest that claims 1-21 are patentable as originally submitted. To expedite prosecution, Applicants have amended claim 17.

Claim 1

Applicants particularly traverse the rejection of claim 1 and claims 2-8 dependent thereon. The Office Action, at page 3, admits that Hill et al., "does not disclose the top edge of the windshield being adhesively secured to the roof portion adjacent the forward edge of the roof portion" as claimed in claim 1. The Office Action

then asserts, however, that Miyazaki et al. teaches that, "it is known to adhesively secure a windshield to an edge of a roof portion" and that, "it would have been obvious to one of ordinary skill ... to have adhesively secured the top edge of the windshield to the roof portion..." Applicants traverse this assertion on the ground that if legally fails to render claim 1 obvious.

As the CAFC has made clear in its caselaw, "there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant" In re Lee 61 USPQ2d 1430, 1433 referencing In re Fine 5 USPQ2d 1596, 1600 (CAFC 1988), Emphasis Added. The Office Action for the present case, however, provides no specific teaching or motivation for "providing a roof module wherein the roof module includes ... a transparent panel having ... a top edge that is adhesively secured to the roof portion". Moreover, there is no specific suggestion to employ a "urethane adhesive" as recited in claim 8. Thus, the Office Action has failed to assert a prima facie case of obviousness for at least claim 1 of the present application and Applicants respectfully request that the rejection of claim 1-8 be withdrawn.

Moreover, Applicants point out that it would likely be improper to present a final rejection of claims 1-8 on a grounds alternative to that already presented since applicants have not amended claim 1 in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." MPEP 706.07(a)

Thus, any new grounds of rejection, "that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." would be improper.

Claim 9

Applicants also particularly traverse the rejection of claim 9 and claims 10-16 dependent thereon. Applicants traverse the rejection on the ground that the Office Action has ignored or glossed over language presented in the claims of the application to arrive at an unwarranted obviousness rejections under 35 U.S.C. § 103. As such, the rejections posited by the Office Action fail to assert a prima facie case of obviousness under 35 U.S.C. § 103. As stated in the MPEP 2143.03, "To establish prima facie obviousness...all the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, the MPEP states that, "All words in a claim must be considered in judging the patentability of that claim again the prior art." In re Wilson, 424 F2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

In this regard, the Office Action, at Page 5, suggests that Hill et al. discloses, "adhesively securing the windshield to the body portion of the vehicle..." and directs attention to the following sections of Hill et al.: column 2, lines 18-27 and 43-67 and column 3, lines 1-7 and figure 2. After review of those sections and Hill et al., Applicants find no mention of adhesively securing a windshield to a body portion of the vehicle. While, Hill et al. may arguably disclose adhesive securing of the pillars 52 and 54, there appears to be no suggestion of adhesively securing the windshield. As such, Applicants suggest that the Office Action fails to assert a prima facie case of obviousness against the present application and the rejection of claims 9-16 should be withdrawn.

Moreover, Applicants point out that it would likely be improper to present a final rejection of claims 9-16 on a grounds alternative to that already presented since applicants have not amended claim 9 in a manner, which would necessitate such alternative grounds. In particular, the MPEP reads:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." MPEP 706.07(a)

Thus, any new grounds of rejection, "that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee..." would be improper.

Claim 17

Applicants have amended claim 17 to include a portion of the language from original dependent claim 19, such language being deleted from claim 19, and additional language. The language reads, "wherein the step of assembling the roof module to the body of the automotive vehicle includes connecting the bottom end of the transparent panel to the body using an adhesive, the adhesive having an elongation that is greater than about 600 percent." Applicants note that such an adhesive can assist in reducing NVH (noise, vibration or harshness) characteristics, which might otherwise be created between the transparent panel and the body of the vehicle.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there

is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

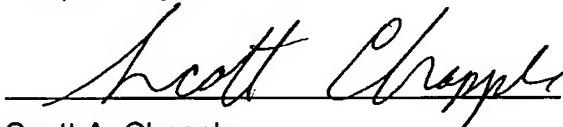
CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 593-9900.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge Deposit Account No. 04-1512 for any fee which may be due.

Respectfully submitted,

Dated: 11-13, 2003



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